



KILPATRICK STOCKTON LLP
1001 WEST FOURTH STREET
WINSTON-SALEM NC 27101

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OFFICE OF PETITIONS

In re Application of
Ponasik et al. :
Application No. 09/776,984 : ON PETITION
Filed: 5 February, 2001 :
Attorney Docket No. 32887.205225 :

This is a response to the petition to withdraw the holding of abandonment, filed on 12 January, 2004.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.181," or as described below under 37 CFR 1.137(b). This is not a final agency action.

This application became abandoned on 21 August, 2003, for failure to timely pay the issue fee as required by the Notice of Allowance and Issue Fee Due, mailed on 20 May, 2003, which set a three (3) month statutory period for reply. Notice of Abandonment was mailed on 26 September, 2003.

Petitioners assert that the Notice of Allowance and Issue Fee Due was never received. Petitioners state that all Office actions were received at counsel's Charlotte, N.C. address and were then forwarded to counsel's Winston-Salem, N.C. office, where the attorney in charge of prosecution, Samuel B. Rollins, had his office. Correspondence was docketed and recorded in petitioners' mail log upon arrival at the Winston-Salem office. Petitioners further asserts that the individual receiving correspondence at the Charlotte office, Bernard Graves, left the employ of counsel after the filing of the present application for patent and went to work for assignee Eastman Chemical Company. In support, petitioners have provided a mail log from the

Winston-Salem office, a statement from petitioners' registered patent attorney, Samuel B. Rollins. As well as a copy of counsel's docket record for the present application.

An allegation that an Office action was not received may be considered as a petition for the withdrawal of the holding of abandonment. If the allegation is adequately supported, the petition may be granted and a new Office action mailed. The petition should include sufficient data describing the procedures and controls utilized by the addressee when correspondence is received from the Patent and Trademark Office. If possible, the addressee should also point out how these procedures and controls were followed in the situation at hand.

The showing of record is not sufficient to withdraw the holding of abandonment.

A review of the written record indicates no irregularity in the mailing of either of the aforementioned communications, and in the absence of any irregularity there is a strong presumption that the communications were properly mailed to the applicant at the correspondence address of record. This presumption may be overcome by a showing that the aforementioned communications were not in fact received.

Petitioner should submit a thorough explanation of how communications from the Patent and Trademark Office are processed when received and copies of all available documentary evidence, such as docket sheets, mail logs, etc., for a reasonable period after the date of the Notice of Allowance and Issue Fee Due of 20 May, 2003, to show receipt of other mail during this period and to support the allegation of nonreceipt of the correspondence in question. Petitioner must submit a statement from the practitioner attesting to the fact that a search of the file jacket and docket records indicates that the final Office action was not received. A copy of the docket record where the non-received Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement.¹ For example, if a three month period for reply was set in the nonreceived Office action, a copy of the docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted a documentary proof of nonreceipt of the Office

¹M.P.E.P. § 711.03(c); See Notice entitled "Withdrawing the Holding of Abandonment When Office Actions Are Not Received," 1156 O.G. 53 (November 16, 1993).

action.² The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office communication may have been lost after receipt rather than a conclusion that the Office communication was lost in the mail.

The evidence presented by petitioners has been carefully considered, but is not persuasive. At the outset, the declaration of attorney Rollins states that all mail was received at the Charlotte office, the correspondence address of record when the Notice of Allowance was mailed, and is then forwarded to the Winston-Salem office, where correspondence is recorded in the mail log. As such, the showing of record is that the Notice mailed on 20 May, 2003, was in fact timely received at the Charlotte office and then misplaced. Petitioners must provide evidence of receipt at the correspondence address of record (the Charlotte office) in order for the holding of abandonment to be withdrawn. If petitioners have a copy of a mail log for the Charlotte office showing correspondence received from the USPTO at that office, such mail log should be submitted with a renewed petition.

Furthermore, the declaration of attorney Rollins states that he was responsible for prosecution of this application "[n]o later than December 2002." It is unclear from this statement whether attorney Rollins was responsible for prosecution of the application in May, 2003, when the Notice of Allowance was mailed. If attorney Rollins was responsible for prosecution of the application in May, 2003, he should so state in a renewed petition. If he was no longer responsible, the attorney who was responsible for the application in May, 2003, should provide a declaration of facts.

Petitioners must provide evidence that either (a) petitioners were receiving mail at the correspondence address of record at the time the Notices were mailed or (b) petitioner notified the PTO of a change in the correspondence address prior to the mailing of the Notices.

MPEP 601.03 requires an attorney or agent of record to promptly notify the Patent and Trademark Office of a change in the correspondence address. The required notification need take no particular form, but must be provided in a manner calling attention to the fact that a change of address is being made. Petitioner failed to timely inform the Office of the address

²Id.

change. Failure by counsel to act properly cannot represent Office error and therefore cannot serve as a basis for withdrawal of the holding of abandonment.

In summary, a review of the record points to the conclusion that the Notice was not received due to petitioners' failure to inform the PTO of a change in the correspondence address or lost after receipt by counsel's Charlotte Office. As such, withdrawal of the holding of abandonment is not proper.

PAYMENT OF THE ISSUE FEE

The papers filed with the present petition do not appear to include authorization to charge the issue fee. Petitioners should provide authorization to charge the issue fee with any renewed petition. Further, there is no indication that petitioner has submitted an Issue Fee Transmittal Form (PTOL-85b).

TERMINAL DISCLAIMER

Although the present petition was not filed within two (2) months of the date that the Notice of Abandonment was mailed, the terminal disclaimer filed with the present petition is unnecessary. This is because any patent term adjustment is automatically reduced under the provisions of 37 CFR 1.704(c)(4) in applications subject to the patent term adjustment provisions of the American Inventors Protection Act of 1999 if a petition to withdraw a holding of abandonment is not filed within two months from the mailing date of the Notice of Abandonment. The Terminal Disclaimer has been entered in the application file but will not be accepted or acted upon. The Terminal Disclaimer fee of \$110.00 will be refunded to counsel's deposit account.

ALTERNATE VENUE

Petitioner may wish to consider filing a renewed petition under 37 CFR 1.137(b), which now provides that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(b). A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by:

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing

application. In a nonprovisional utility or plant application filed on or after 8 June, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

(2) the petition fee as set forth in 37 CFR 1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and

(4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c)).

The filing of a petition under the unintentional standard cannot be intentionally delayed and therefore should be filed promptly. A person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b).

A copy of the form for filing a petition under 37 CFR 1.137(b) to revive an application unintentionally abandoned is enclosed herewith for petitioner's convenience.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: (703) 872-9306
 Attn: Office of Petitions

By hand: U.S. Patent and Trademark Office
 2011 South Clark Place
 Customer Window
 Crystal Plaza 2, Lobby, Room 1B03
 Arlington, VA 22202

Telephone inquiries concerning this matter may be directed to the undersigned at (703)308-6918.



Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

Enclosures: Form PTO/SB/64
 Fee Schedule FY03
 Privacy Act Notification